



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,157	09/11/2003	Howard Andrew Gutowitz	2003,001/TS	2156
21909	7590	04/16/2008	EXAMINER	
CARR LLP 670 FOUNDERS SQUARE 900 JACKSON STREET DALLAS, TX 75202				NGUYEN, TANH Q
ART UNIT		PAPER NUMBER		
2182				
			MAIL DATE	DELIVERY MODE
			04/16/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/605,157	GUTOWITZ, HOWARD ANDREW
	<b>Examiner</b>	<b>Art Unit</b>
	TANH Q. NGUYEN	2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 31 March 2008 (RCE).  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.  
 4a) Of the above claim(s) 2,4-6,12,13 and 20-24 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,3,7-11 and 14-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 26 April 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 03/14/08.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 2, 2007 has been entered.

### ***Election/Restrictions***

2. Newly submitted claims 21-24 are directed to inventions that are independent or distinct from the invention originally presented for the following reasons:

Claims 1, 3, 7-11 and 14 are directed to a subcombination (Invention I) that includes printable symbols, non-conversion symbols, symbol-input-end symbols which can be input by keystrokes on keys having printable symbols assigned to them, classes of trigger sequences, and a last symbol-input-end symbol - among others.

Claim 21 is directed to a subcombination (Invention II) that includes a plurality of symbol-input-end symbols (that are different from those in Invention I), pre-conversion symbols displayed by a first mechanism, a second keystroke that does not additionally display any of pre-conversion symbols which follow a pre-conversion symbol in any sequence of pre-conversion symbols which corresponds to a post-conversion symbols, and conversion without the need for a keystroke on a dedicated convert key or a

keystroke on a key having at least one pre-conversion assigned to it.

Claims 22-24 are directed to a subcombination (Invention III) that includes post-conversion symbols distinct from pre-conversion symbols, and recognition of a trigger sequence upon a keystroke generating symbol-input-end symbols (that are different than those of Invention I) without a further keystroke dedicated to causing conversion of a pre-conversion symbol to a post-conversion symbol.

3. Invention I and Inventions II-III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they have different scopes and are not obvious variants, and if it is shown that at least one subcombination is separately usable. See MPEP § 806.05(d).

In the instant case, applicant indicates that claims 21 and 22 present different aspects of the invention – hence the subcombinations not having the same scope.

In the instant case, applicant did not indicate that the subcombinations are obvious variants of each other.

In the instant case, Invention II has separate utility such as - a plurality of symbol-input-end symbols (that are different from those in Invention I), pre-conversion symbols displayed by a first mechanism, a second keystroke that does not additionally display any of pre-conversion symbols which follow a pre-conversion symbol in any sequence of pre-conversion symbols which corresponds to a post-conversion symbols, and conversion without the need for a keystroke on a dedicated convert key or a keystroke on a key having at least one pre-conversion assigned to it.

In the instant case, Invention III has separate utility such as - post-conversion

symbols distinct from pre-conversion symbols, and recognition of a trigger sequence upon a keystroke generating symbol-input-end symbols (that are different than those of Invention I) without a further keystroke dedicated to causing conversion of a pre-conversion symbol to a post-conversion symbol.

The examiner has required restriction between subcombinations usable together. Where a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Restriction for examination purposes as indicated is proper because all the inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching

different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first and second paragraphs.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-24 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Note further that claims 2, 4-6, 12 should be listed as "withdrawn" because they were previously withdrawn.

### ***Drawings***

5. The drawings are objected to under 37 CFR 1.83(a). Amended FIG. 1 was submitted on April 26, 2006 and contained new matter in elements 101 and 103.

In the response filed February 2, 2007, applicant indicates cancellation of the amendments made on April 26, 2006 to FIG. 1. The indication alone is not sufficient to overcome the objection to the drawings made on the office action mailed November 2, 2006.

A new corrected drawing in compliance with 37 CFR 1.121(d) is required in this application because a replacement for FIG. 1, without the new matter in elements 101

Art Unit: 2182

and 103, has not been filed. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

## **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

### **Annotated Drawing Sheets**

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

***Specification***

6. The amendment filed April 26, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

--and optionally non-conversion symbols-- **was added to box 100 of FIG. 1.**

"b) another keystroke in the subsequence i) generates a symbol-input-end symbol which applies to the given pre-conversion symbol, and ii) does not additionally display any pre-conversion symbols which follow the given pre-conversion symbol in any sequence of pre-conversion symbols which correspond to a post-conversion symbol" **was replaced with** -- b) subsequent keystrokes in the subsequence i) generates a symbol-input-end symbol which applies to an immediately previous pre-conversion symbol, and ii) additionally causes display of a further printable symbol which is a pre-conversion symbol or a non-conversion symbol-- **in box 103 of FIG. 1.**

Applicant is required to cancel the new matter in the reply to this Office Action.

***Information Disclosure Statement***

7. The information disclosure statement (IDS) filed March 14, 2008 includes an

extraordinary large number of references. The references are considered on the bases that applicant does not particularly point out the references germane to the claims within the application, and that applicant considers the invention to be distinguishable over the references cited.

Note that, per MPEP 2004 (.13), it is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance. See Penn Yan Boats, Inc. v. Sea Lark Boats, Inc., 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), aff 'd, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), cert. denied, 414 U.S. 874 (1974). But cf. Molins PLC v. Textron Inc., 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

An applicant's duty of disclosure of material and information is not satisfied by presenting a patent examiner with "a mountain of largely irrelevant [material] from which he is presumed to have been able, with his expertise and with adequate time, to have found the critical [material]. It ignores the real world conditions under which examiners work." Rohm & Haas Co. v. Crystal Chemical Co., 722 F.2d 1556, 1573 [220 USPQ 289] (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (Emphasis in original). Patent applicant has a duty not just to disclose pertinent prior art references but to make a disclosure in such way as not to "bury" it within other disclosures of less relevant prior art; See Golden Valley Microwave Foods Inc. v. Weaver Popcorn Co. Inc., 24 USPQ2d 1801 (N.D. Ind. 1992); Molins PLC v. Textron Inc., 26 USPQ2d 1889, at

1899 (D.Del. 1992); Penn Yan Boats, Inc. v. Sea Lark Boats, Inc. et al., 175 USPQ 260, at 272 (S.D. Fl. 1972).

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 3, 7-11, 14-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 3, 7-11, 14-19 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said keystrokes" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites "more than one sequence of said pre-conversion symbols" in lines 8-9. The limitation suggests each sequence having all the pre-conversion symbols recited in line 5, and therefore not enabled by the disclosure.

Claim 1 recites "a sequence of said pre-conversion symbols" in lines 10-11. The

limitation suggests a sequence having all the pre-conversion symbols recited in line 5, and therefore not enabled by the disclosure.

Claim 1 recites "said corresponding sequence of said pre-conversion symbols" in line 11. The limitation suggests a sequence having all the pre-conversion symbols recited in line 5, and therefore not enabled by the disclosure.

Claim 1 recites "said corresponding sequence of said pre-conversion symbols comprising at least one of said pre-conversion symbols" in lines 11-12. A sequence of symbols suggests a plurality of symbols. At least one of the symbols suggests the possibility of one symbol. The claim is not enabled because one symbol precludes a plurality of symbols, and vice versa.

Claim 1 recites "each of said post-conversion symbols being set in a correspondence to a sequence of said-pre-conversion symbols, said corresponding sequence of said pre-conversion symbols comprising at least one of said pre-conversion symbols" in lines 10-12. It is not clear whether "said corresponding sequence" refers to the sequence in line 10, or one of the sequences in lines 8-9.

Claim 1 recites "a plurality of symbol-input-end symbols which can be input by a keystroke on keys having a printable symbol assigned to them" in lines 13-14. The limitation is ambiguous because a plurality of symbol-input-end symbols cannot be input by one keystroke, because one keystroke cannot be input on a plurality of keys, and because a plurality of keys cannot have only one printable symbol assigned to them.

Claim 1 recites "to display said printable symbols in response to keystrokes" in line 16. It is not clear whether "said printable symbols" refers to printable symbols in

line 15, or printable symbols in line 3.

Claim 1 recites “a second mechanism to recognize, upon input of a symbol-input-end symbol, elements of a set of trigger sequences of said keystrokes and thereby trigger conversion of a pre-conversion sequence comprising at least one said pre-conversion symbol displayed on said display to a post-conversion sequence comprising said a post-conversion symbol” in line 17-20.

The limitation “said keystrokes” appears to refer to the keystrokes in line 16, hence not including a keystroke corresponding to symbol-input-end symbol in line 17. The specification does not appear to support a set of trigger sequences that does not include a keystroke corresponding to symbol-input-end symbol.

The limitation “a pre-conversion sequence comprising at least one said pre-conversion symbol” suggests a plurality of pre-conversion symbols. The limitation “at least one said pre-conversion symbol” suggests the possibility of one pre-conversion symbol. The claim is not enabled because one symbol precludes a plurality of symbols, and vice versa.

The limitation “a post-conversion sequence comprising a post-conversion symbol” suggests a plurality of post-conversion symbols. The claim is not enabled because one symbol precludes a plurality of symbols, and vice versa.

There is insufficient antecedent basis for “said pre-conversion symbol” in the claim.

Claim 1 recites “said set of trigger sequences comprising classes of said trigger sequences, said classes comprising a first class of said trigger sequences” in lines 21-

22. There is insufficient antecedent basis for “said trigger sequences” in the claim.

Claim recites “said trigger sequences in said first class of said trigger sequences characterized in that they comprise a subsequence of said keystrokes” in lines 23-24. There is insufficient antecedent basis for “said trigger sequences in said first class of said trigger sequences” in the claim. Furthermore, it is not clear whether “said keystrokes” refers to keystrokes in line 16 or keystrokes in line 18.

Claim 1 recites “said subsequence comprising at least two of **said keystrokes** such that a first keystroke of **said subsequence said keystrokes** causes said first mechanism to display **a first said pre-conversion symbol**, and where each subsequent one of **said keystrokes** on a key having a printable symbol assigned to it generates **a said symbol-input-end symbol** which applies to **an immediately previously displayed said printable symbol** to cause input of **said immediately previously displayed said printable symbol** and additionally causes display of **a further said printable symbol** assigned to said key” in lines 25-35.

The limitations highlighted above are ambiguous, and/or appear to not have proper antecedent bases – hence making the claim indefinite because the metes and bounds of the claim cannot be determined.

Furthermore, it does not appear that there is enablement in the specification for each keystroke after the first keystroke to be a symbol-input-end symbol to cause input of an immediately previously displayed printable symbol (Note that a printable symbol is not necessarily a pre-conversion symbol, in that the printable symbol may be a post-conversion symbol or a non-conversion

symbol).

In addition, the limitation “each subsequent one of said keystrokes” suggests more than one subsequent keystrokes. In combination with the first keystroke, the subsequence would comprise more than two keystrokes. The limitation “said subsequence comprising at least two of said keystrokes” is therefore not enabled because it suggests the possibility of only two keystrokes.

Claim 1 recites “where a last keystroke of said subsequent subsequence of keystrokes generates **a last said symbol**-**input-end symbol** applying to **a last said immediately previously displayed said printable symbol**, and additionally displays a printable symbol assigned to the key of said last keystroke” in lines 36-39.

The limitations highlighted above are ambiguous, and there is insufficient antecedent basis for “said subsequent subsequence of keystrokes”.

In addition, “a last keystroke of said subsequent subsequence of keystrokes”, in combination with the first keystroke, and a keystroke subsequent to the first keystroke (see lines 25-35 of the claim) would comprise at least three keystrokes. The limitation “said subsequence comprising at least two of said keystrokes” is therefore not enabled because it suggests the possibility of only two keystrokes.

Claim 1 recites “**said last said further printable symbol** characterized as displayed and not converted when **said last said immediately previously displayed said printable symbol** is converted, **said last of said subsequent subsequence keystroke** completing said trigger sequence, so that it is recognized by said second

mechanism, permitting conversion to a post-conversion symbol before any further keystroke is made and while also causing display of **a said printable symbol** assigned to the key of said last keystroke for possible later inclusion in a subsequent sequence of pre-conversion symbols corresponding to a subsequent post-conversion symbol.

The limitations highlighted above are ambiguous, and there are insufficient antecedent bases for “said last said further printable symbol”, “said last of said subsequent subsequence keystroke”.

The limitation “when said last said immediately previously displayed said printable symbol is converted” is not enabled because the specification appears to support a sequence of pre-conversion symbols to be converted rather than only the last immediately previously displayed pre-conversion symbol. Furthermore, the claim is not enabled because the specification does not support conversion of a non-conversion symbol or conversion of a post-conversion symbol (note that printable symbol is either a pre-conversion, a post-conversion symbol, or a non-conversion symbol).

The limitation “said last of said subsequent subsequence keystroke” is ambiguous because “said subsequent subsequence keystroke” suggests only one keystroke – hence making last ambiguous.

The limitations “said last said further printable symbol characterized as displayed” and “while also causing display of a said printable symbol assigned to the key of said last keystroke” suggest displaying the last pre-conversion symbol twice.

Claim 1 also recites “2) a plurality of printable symbols” in line 3, and further “3) said plurality of printable symbols” in line 4. The limitations “2)” and “3)” suggest two different components of the text-entry system, while “said plurality of printable symbols” in 3) suggests the same plurality of printable symbols in 2). “3)” needs to be merged with “2)”, and “4)” to “7)” needs be replaced with “3)” to “6)”.

Claim 3 recites “The text-entry system of claim 1 further characterized in that 1) said pre-conversion symbols comprise cHiragana, 2) said post-conversion symbols comprise Kanji, 3) said non-conversion symbols comprise Hiragana, and 4), said classes comprise a second class, elements of said second class characterized in that they comprise **a first said keystroke** which causes said first mechanism to display **a first said cHiragana**, and **a second said keystroke** which generates **a first said symbol-input-end symbol, said first said symbol-input-end-symbol** applying to **said displayed first said cHiragana** causing it to be input, where **said second said keystroke** is on a **cHiragana-free said key**, characterized in that **it has not been assigned any of said cHiragana**, and elements of said first class are further characterized in that **said first subsequence said keystroke** causes said first mechanism to display **a first subsequence said cHiragana**, and **a first subsequent subsequence said keystroke** generates one of said symbol-input-end symbols, said symbol-input-end-symbol generated by **said first subsequent subsequence said keystroke** applying to **said first subsequence said cHiragana** causing it to be input, where **said first subsequent subsequence said keystroke** also causes one of said Hiragana to be displayed by said first mechanism and **a second subsequent**

**subsequence said keystroke** which generates **a second subsequence said symbol-input-end symbol, said second subsequence said symbol-input-end symbol** applying to **said displayed said Hiragana** causing it to be input.

The limitations highlighted above are ambiguous, and there is insufficient antecedent basis for “said first subsequence said keystroke”.

Claim 7 recites “The text-entry system of claim 1 further comprising a third mechanism to convert said pre-conversion symbols to said post-conversion symbols upon recognition of said trigger sequences by said second mechanism”.

It does not appear that the specification provides enablement for the limitations “a third mechanism to convert said pre-conversion symbols to said post-conversion symbols” – as the limitation suggests all pre-conversion symbols being converted to all post-conversions symbols (note that the specification suggests a sequence of pre-conversion symbols being converted to a post-conversion symbol, and it is not clear that the specification suggests a sequence of pre-conversion symbols being converted to a sequence of post-conversion symbols). There is also insufficient antecedent basis for “said trigger sequences”.

Claim 11 recites “The text-entry system of claim 1 further comprising at least one Next key for incrementing symbols in an ordered list containing more than one element, said Next key characterized in that a **said keystroke** on said Next key does not generate **a said symbol-input-end symbol**”.

The limitations highlighted above are ambiguous, and there is insufficient

antecedent basis for “said Next key”.

Claim 14 recites “The text-entry system of claim 1 further comprising **a first Next said key** applying to a plurality of said pre-conversion symbols assigned to **a same said key** such that **a said keystroke on said first Next said key** advances **said same-key-assigned said pre-conversion symbols** in an order, and **a second Next key** applying to a plurality of said non-conversion symbols assigned to **a same said key** such that **a said keystroke on said second Next said key** advances **said same-key-assigned said non-conversion symbols** in an order, **said first Next key** characterized in that **a said keystroke** on **said first Next key** does not generate **a said symbol-input-end symbol**, and **said second Next key** characterized in that a **said keystroke** on **said second Next key** does not generate **a said symbol-input-end symbol**”.

The limitations highlighted above are ambiguous, and there are insufficient antecedent bases for “said first Next key” and “said second Next key”.

Claim 16 recites “A method for constructing trigger sequences for a text-entry system comprising the steps of 1) selecting a set of printable symbols from a set consisting of pre-conversion symbols, post-conversion symbols, and non-conversion symbols, 2) assigning said pre-conversion symbols to keys such that at least **one said key** is assigned more than **one said pre-conversion symbol** 3) selecting a text-entry mechanism which enters text in response to keystrokes, 4) selecting a set of sample text sequences 4) for each member of said set of selected sample text sequences determining **a corresponding said keystroke sequence** which causes said text-entry system to enter **said selected sample text sequence, said corresponding said**

**keystroke** characterized in that it does not contain **a said keystroke on a conversion said key, said conversion said key** characterized as converting a subset of **displayed said pre-conversion symbols** to a subset of said post-conversion symbols, without additionally causing display of further printable symbols where said further printable symbols are selected from the set consisting of said pre-conversion symbols and said non-conversion symbols, 5) for **each said corresponding said keystroke sequence**, and for **each said pre-conversion symbol** generated by **each said corresponding said keystroke sequence**, finding a subsequence of said keystrokes such that said subsequence comprises at least two of said keystrokes such that **a first said subsequence keystrokes** causes display of **a first said pre-conversion symbol**, and **subsequent said keystrokes** in said subsequence are characterized in that they generate a symbol-input-end symbol, where **said generated said symbol-input-end symbol** applies to **an immediately previously displayed said printable symbol** to cause input of **said immediately previously displayed said printable symbol** and where each of **said subsequent said keystrokes** additionally causes display of **a said further said printable symbol, said further said printable symbol** being either a **said pre-conversion symbol or a said non-conversion symbol**, where a last of **said subsequent said keystrokes** completes said trigger sequence, and thereby triggers conversion.

The limitations highlighted above are ambiguous, and there are insufficient antecedent bases for “said selected sample text sequence” and “said pre-conversion symbol”, “said keystrokes”, “said trigger sequence”.

It is not clear what “said corresponding said keystroke characterized in that it does not contain a said keystroke on a conversion said key” means in the limitation “4) for each member of said set of selected sample text sequences determining a corresponding said keystroke sequence which causes said text-entry system to enter said selected sample text sequence, said corresponding said keystroke characterized in that it does not contain a said keystroke on a conversion said key, said conversion said key characterized as converting a subset of displayed said pre-conversion symbols to a subset of said post-conversion symbols”. It is further not clear that there is enablement in the specification for “said conversion said key characterized as converting a subset of displayed said pre-conversion symbols to a subset of said post-conversion symbols” - as the specification appears to support converting a plurality of pre-conversions to one post-conversion symbol (see FIG. 13).

It is not clear that there is enablement in the specification for the portions underlined in the limitation “5) for each said corresponding said keystroke sequence, and for each said pre-conversion symbol generated by each said corresponding said keystroke sequence, finding a subsequence of said keystrokes such that said subsequence comprises at least two of said keystrokes such that a first said subsequence keystrokes causes display of a first said pre-conversion symbol, and subsequent said keystrokes in said subsequence are characterized in that they generate a symbol-input-end symbol” – as the specification appears to support one pre-conversion symbol per keystroke

instead of per sequence of keystrokes, and one keystroke generating a symbol-input-end symbol instead of a sequence of keystrokes (see FIG. 13).

Claim 16 also recites “4)…”, “4)…”, “5)…”. The numbering should be “4)…”, “5)…”, “6)…” instead.

11. Because of the numerous outstanding 112 issues, the metes and bounds of the subject matter claimed cannot be readily determined. It is therefore not possible for the examiner to search for, and to apply prior art without a great deal of speculation.

The examiner acknowledges from the interview dated March 18, 2008 that applicant intends to claim the trigger sequence illustrated in FIG. 13 of applicant's disclosure, and recognizes that the prior art of record (Ouyang – US 6,765,504) does not teach such trigger sequence.

Since the recited claims 1, 3, 7-11, 14-19 do not particularly point out and distinctively define the metes and bounds of the subject matter illustrated by FIG. 13 of applicant's disclosure (i.e. the trigger sequence of FIG. 13), it is not clear that the recited claims have overcome Ouyang, and it is further not possible for the examiner to search for and to properly apply other prior art.

The invention needs to be claimed in a way to particularly point out distinctively define the metes and bounds of the subject matter illustrated by FIG. 13 of applicant's disclosure, and in a way to preclude any other trigger sequence besides the trigger sequence illustrated in FIG. 13 of applicant's disclosure to overcome Ouyang or any prior art not teaching such trigger sequence.

The examiner suggests that applicant maps each limitation when amending the

claims to specific teachings in the disclosure (preferably by column, line numbers and/or labels and drawings of US publication 2005/0060448 – by Gutowitz) to help the examiner determine the scope of the claims and further the prosecution.

***Response to Arguments***

12. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TANH Q. NGUYEN whose telephone number is (571)272-4154. The examiner can normally be reached on M-F (9:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TARIQ HAFIZ can be reached on (571)272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Application/Control Number: 10/605,157  
Art Unit: 2182

Page 22

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TANH Q. NGUYEN/  
Primary Examiner, Art Unit 2182

TQN: April 11, 2008